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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/803,698	03/18/2004	Michael E. Miller	65937-0047	6051
10/29/759004/30/2008 RADER, FISHMAN & GRAUER PLLC 39533 WOODWARD AVENUE SUITE 140 BLOOMFIELD HILLS, MI 48304-0610				
EXAMINER				
FOREMAN, JONATHAN M				
ART UNIT		PAPER NUMBER		
3736				
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04/30/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/803,698

Applicant(s)

MILLER ET AL.

Examiner

JONATHAN ML FOREMAN

Art Unit

3736

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9, 11, 13-16 and 21-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9, 11, 13-16 and 21-34 is/are rejected.
- 7) ☒ Claim(s) 34 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 26 and 32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear if the guide lock referred to in claims 26 and 32 is intended to be the same or different as that in claim 9.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 9, 14, 15, 21 – 24 and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,871,487 to Warner et al.

In regard to claims 9, 14, 15, 21 – 24 and 30 Warner et al. disclose a base (12); a cradle (32) movably mounted to the base; and an indexing guide moveable with the cradle and including a receptacle (36) within which a portion of the medical instrument is received, the indexing guide including a guide lock (38) slidably attached to the indexing guide and selectively engagable with a portion of the medical instrument received within the receptacle to prevent rotation and axial movement of the portion of the medical instrument received in the receptacle relative to the indexing guide and the cradle when the medical instrument is locked therein (Col. 4, lines 44 – 46).

The guide lock is moveably secured to the indexing guide. The indexing guide includes a lip adjacent the receptacle (Figure 1). Warner et al. disclose a pivotable clamp (48) axially disposed a distance away from the guide lock that is selectively engagable with the medical instrument to inhibit rotation and axial movement (Col. 5, lines 7 – 9).

5. Claims 9, 14 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. U.S. Patent No. 6,451,027 to Cooper et al.

In regard to claims 9, 14 and 16, Cooper et al. disclose a base (18); a cradle (20) movably mounted to the base; and an indexing guide (22) moveable with the cradle and including a receptacle within which a portion of the medical instrument is received, the indexing guide including a guide lock slidably attached to the indexing guide and selectively engagable with a portion of the medical instrument received within the receptacle configured to inhibit rotation and axial movement of the portion of the medical instrument received in the receptacle relative to the indexing guide and the cradle when the medical instrument is locked therein (Col. 8, line 43 – Col. 9, line 37). The indexing guide includes a lip adjacent the receptacle. Cooper et al. disclose a deployment mechanism configured to move the cradle relative to the base (Col. 10, lines 10 – 14).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,871,487 to Warner et al.

In regard to claim 11, Warner et al. disclose the indexing guide including a guide lock, but fails to disclose two guide locks. However, duplicating the components of a prior art device is a design consideration within the skill of the art. *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960). It would have been obvious to one having ordinary skill in the art at the time the invention was made to duplicate the guide lock as disclosed by Warner et al. to more securely hold the medical instrument in place.

8. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,871,487 to Warner et al. in view of U.S. Patent No. 7,166,114 to Moctezuma De La Barrera et al.

In regard to claim 13, Warner et al. disclose a guide lock that engages a portion of a medical instrument to inhibit rotation and axial movement, but fail to disclose the medical instrument including at least one notch and the guide lock being configured to be received in the notch to prevent movement of the medical instrument. Moctezuma De La Barrera et al. teach a guide lock (122) that engages a portion of a medical instrument to inhibit rotation and axial movement, wherein the medical instrument including at least one notch and the guide lock being configured to be received in the notch (Col. 6, lines 40 – 51). The claim would have been obvious because the substitution of one known element for another would have yielded predictable results to one of ordinary skill in the art at the time of the invention. Because both Warner et al. and Moctezuma De La Barrera et al. teach means for locking a medical instrument within a receptacle, it would have been obvious to one skilled in the art at the time of the invention to substitute one guide lock for the other to achieve the predictable results of holding the medical instrument in a fixed relation to the receptacle.

9. Claims 25 – 29 and 31 rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,871,487 to Warner et al. in view of DE 935,625 to Bodendieck et al.

In regard to claims 25 – 29 and 31, Warner et al. disclose the cradle allowing for rotatably supporting a medical device therein for positioning of the device and the medical instrument being a biopsy device (Col. 5, line 40), but fail to disclose the biopsy device having a handpiece and a cutting element having an outer hub, wherein the cutting element comprises an outer cannula connected to the outer cannula hub and defining a tissue receiving opening and an inner cannula disposed within the outer cannula and attached to the handpiece. Bodendieck et al. teach a biopsy device (Figures 1, 2, 3) having a handpiece and a cutting element having an outer hub, wherein the cutting element comprises an outer cannula (2) connected to the outer cannula hub (Figure 2) and defining a tissue receiving opening (Figure 8) and an inner cannula (3) disposed within the outer cannula and attached to the handpiece (Figure 3). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the biopsy device disclosed by Bodendieck et al. with the microdrive device taught by Warner et al. in order to permit safe and accurate placement of the biopsy device at the desired location (See Abstract).

Response to Arguments

10. Applicant's arguments filed 1/31/08 been fully considered but they are not persuasive. Applicant asserts that neither Warner et al. nor Cooper et al. disclose a guide lock slidably attached to the indexing guide. However, the Examiner disagrees. Although, Warner et al. disclose a screw (38), the Examiner considers the screw slidably attached to the indexing guide in that when loosened to tightened the surface of the threads and the receptacle slide past one another. In regard to Cooper et al., the Examiner considers the guide lock to be formation (90) which is slidably attached to the indexing guide (Col. 9, lines 17 - 21) and engagable with the portion of the medical instrument received within the receptacle.

Allowable Subject Matter

11. Claims 32 and 33 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims. Claim 34 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JONATHAN ML FOREMAN whose telephone number is (571)272-4724. The examiner can normally be reached on Monday - Friday 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571)272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3736

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, /contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. M. F./
Examiner, Art Unit 3736

/Max Hindenburg/
Supervisory Patent Examiner, Art Unit 3736